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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,705

09/20/2006

Akira Yasuki

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EXAMINER

PATEL, VISHAL A

ART UNIT

PAPER NUMBER

3676

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,705	<b>Applicant(s)</b> YASUKI, AKIRA	
	<b>Examiner</b> Vishal Patel	<b>Art Unit</b> 3676	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-4,6,8,9 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-4,6,8,9 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly amended claims 1-4, 6, 8-9 and 11-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Now applicant is claiming a method for manufacturing a gasket, which is directed to a non-elected invention. Furthermore the gasket as claim in claim 14 can be formed by a different method and one does not have to bending method step to form the deformation restricting portion.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-4, 6, 8-9 and 11-13 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 14-16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanou et al (JP 63125864A).

Kanou disclose a gasket having a gasket plate made of an electrically insulating material (e.g. 10), the gasket plate having a hole (e.g. hole 9 that corresponds to combustion opening), an annular sealing member (e.g. 14) of a material having a higher heat resistance than the gasket plate, the annular sealing member covers part of the gasket that defines hole (figure 1), the

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annular sealing member having a pair of holding portions (portions that are on each sides of 10 near the hole 9) that holds the gasket plate in between, a coupler portion (coupler portion 11 that are above 5) that couples the holding portions to each other in the hole, the gasket further comprising a deformation restricting portion (e.g. 13 which has a thickness) that restricts deformation of the annular sealing member along the thickness of the gasket plate. The gasket of Kanou can be used as intended by applicant (e.g. fluid is combustion gas or the gasket is used between block). The deformation restricting portion extends along the thickness of the gasket plate between the holding portions (figure 1). The deformation restricting portion has a length that is substantially equal to the thickness of the gasket plate (has a thickness substantially equal to the thickness that is held by the holding portions). The restricting portion is formed by bending (method limitations given little patentable weight in an apparatus claim) part of one of the holding portions toward the other holding portion (for claim 10, the holding portion includes a bend portion 14a and the coupling portion is bent portion 15a). The gasket plate is formed of a single plate member (figure 1).

Regarding limitation that the deformation restricting portion is formed by bending is considered to be method limitations and given little patentable weight in an apparatus claim. Furthermore the reference of Kanou teaches that the structure of the deformation restricting portion (e.g. deformation restricting portion that restricts deformation of the annular sealing member along the thickness of the gasket plate).

4. Claims 14, 18, 19-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (JP 02157629).

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Ishida discloses a gasket having a gasket plate made of an electrically insulating material (e.g. 55a and 55b), the gasket plate having a hole (e.g. hole 8 that corresponds to combustion opening), an annular sealing member (e.g. 57 to 59) of a material having a higher heat resistance than the gasket plate, the annular sealing member covers part of the gasket that defines hole (figure 8), the annular sealing member having a pair of holding portions (e.g. portions 57 and 59) that holds the gasket plate in between, a coupler portion (e.g. coupler portion 58) that couples the holding portions to each other in the hole, the gasket further comprising a deformation restricting portion (e.g. 62) that restricts deformation of the annular sealing member along the thickness of the gasket plate. The deformation restricting portion is perpendicular to the holding portions. The gasket of Ishida can be used as intended by applicant (e.g. fluid is combustion gas or the gasket is used between block). The deformation restricting portion extends along the thickness of the gasket plate between the holding portions (figure 8). The deformation restricting portion has a length that is substantially equal to the thickness of the gasket plate (has a thickness substantially equal to the thickness that is held by the holding portions). The gasket having a sensor (e.g. 12a or 12b), the gasket plate having a guide hole (figures 1-8) and a lead extending from the sensor passes through the guide hole (figure 8). The annular sealing member is formed by a plate member (inner portion 58 of the plate member).

Regarding limitation that the deformation restricting portion is formed by bending is considered to be method limitations and given little patentable weight in an apparatus claim. Furthermore the reference of Ishida teaches that the structure of the deformation restricting portion (e.g. deformation restricting portion that restricts deformation of the annular sealing member along the thickness of the gasket plate).

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanou.

Kanou discloses the claimed invention except for the insulating material being resin and the heat resistance material being stainless steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the gasket plate be made of resin and the annular sealing member to be made of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Using the material of resin provides predictable result of high electrical insulation and using stainless steel provides predictable result of being used in high temperature environment.

***Response to Arguments***

7. Applicant's arguments filed 6/17/08 have been fully considered but they are not persuasive.

Applicants' argument to the translation must be obtained is correct but the abstract provides support in view of the drawings to teach all the structural limitations of the claims. Abstract and constitution of Japanese patents.

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Applicants' argument to the method limitations is not persuasive because method limitations are given little patentable weight in an apparatus claim. Furthermore the reference of Kanou and Ishida teach all the structural limitations of the claims (please see above rejection).

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. P./

Primary Examiner, Art Unit 3676

/Vishal Patel/

Primary Examiner, Art Unit 3676